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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,765

05/05/2005

Marc Poirot

0600-1318

6680

466 7590 09/20/2010

YOUNG & THOMPSON
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EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1628

NOTIFICATION DATE

DELIVERY MODE

09/20/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/511,765	Applicant(s) POIROT ET AL.	
	Examiner Barbara P. Badio	Art Unit 1628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 12-19 and 29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 12-19 and 26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/2/2010</u> . | 6) <input type="checkbox"/> Other: ____. |

Final Office Action on the Merits of a RCE

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Application

2. Claims 1, 12-19 and 26 are pending in the present application. The instant claims are rejected as indicated below.

Claim Rejections - 35 USC § 112

3. The rejection of claims 12-18 under 35 USC 112, first paragraph, scope of enablement is maintained.

Applicant argues, in the presently claimed process, solvents are used to perform a chemical reaction as defined by steps a) and b) and are defined by their utilization. Applicant also argues activator D is used to activate step b) of the process and may be lithium perchlorate. Accordingly, it is applicant's position that a) the present specification provides examples of solvents that may be used in the claimed process and b) the action of a catalyst in a reaction between an epoxy compound and an amine is well known in the art and, thus, the claimed process and the present specification are enabling. Applicant's argument was considered but not persuasive for the following reasons.

The issue is not the use of solvents/catalysts in the present process but what is encompassed by solvent A, solvent B, solvent C, solvent E and activator D. 35 USC 112 requires the specification to contain a written description of the claimed invention in full, clear, concise and exact terms as to enable the skilled artisan to use the claimed invention not an indication of a result that one might hope to achieve using a solvent or activator as encompassed by the instant claims.

As previously noted, based on the unpredictability of the solubility of compounds in various solvents and the effect of catalysts/activator, the skilled artisan would be unable to ascertain the solvents and catalysts, apart for the specific solvents and activators set forth in the present specification, that are useful in the present invention with undue experimentation.

For this reason and those given in the previous Office Action, the rejection of claims 12-18, first paragraph, scope of enablement is maintained.

- 4. The rejection of claims 12-18 under 35 USC 112, first paragraph, as failing to comply with the written description requirement is withdrawn.**
- 5. The rejection of claims 1, 19 and 26 under 35 USC 112, second paragraph is withdrawn.**
- 6. The rejection of claims 12-18 under 35 USC 112, second paragraph is maintained.**

Applicant argues the terms “solvent” and “activator” are basic chemical terms which are clear for the man skilled in the art and, thus, all solvents can be used as long as they can dissolve meta-chloroperoxybenzoic acid (solvent A), dissolve compound of formula (III) (solvent B), dissolve the epoxy compound (solvent C), dissolve the amine (solvent E), and that solvent B is miscible with solvent A and that solvent E is miscible with solvent C. Thus, it is applicant's position that solvents A, B, C, E and activator D are definite terms. Applicant's argument was considered but not persuasive for the following reason.

The issue is not the definition of “solvent” and “activator”. As noted by applicant, said terms are basic chemical terms. The issue is what is meant by solvent A, solvent B, solvent C, solvent E and activator D. 35 USC 112, second paragraph states the specification **shall** conclude with one or more claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention". The claims do not particularly point out and distinctly claim what is encompassed by the terms “solvent A”, “solvent B”, “solvent C”, “solvent E” and “activator D”. The present specification also lacks a clear definite of the above-mentioned terms and, thus, the metes and bound of the instant claims are indefinite.

For this reason and those given in previous Office Actions, the rejection of claims 12-18 under 35 USC 112, second paragraph is maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/
Primary Examiner, Art Unit 1628